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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,824	04/27/2001	Mieko Tanaka	109358	8472

25944            7590            07/31/2003  
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[REDACTED] EXAMINER

FERGUSON, LAWRENCE D

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

1774

DATE MAILED: 07/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	09/842,824	TANAKA ET AL.
	Examiner	Art Unit
	Lawrence D Ferguson	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 May 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 13, 14, 16, 21 and 25 is/are rejected.
- 7) Claim(s) 15, 17-20 and 22-24 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed May 05, 2003.

Claims 1-11 were cancelled, claims 12-13 and 21 were amended and claims 22-25 were added rendering claims 12-25 pending. The previous restriction requirement of cancelled claims 1-11 has been withdrawn; however, the restriction requirement of amended claim 12 is maintained, rendering claim 12 to be a non-elected invention.

### ***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 13-14, 16, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usami (U.S. 6,376,040) in view of Applicants' own admissions.

Usami discloses a molded recording medium (column 1, lines 8-16 and lines 50-63) comprising a recordable layer and lens layer with plural lenses (column 2, lines 11-49). Usami discloses the substrate is made of resins (column 4, lines 29-38) and the plural lenses are concave where a resin layer is provided on the surface of the recordable layer (column 8, line 44 through column 9, line 6). Usami discloses the

substrate may comprise polycarbonate (column 4, lines 29-38). The reference discloses a central hole is formed (column 10, lines 22-40) in the recording medium. Usami discloses the lens layer is formed from a resin by molding (column 13, lines 30-46). In instant claim 13, 'a resin film formation area' constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform. Usami does not disclose a ridgy resin film raised above surface of the resin layer. Applicant admits a recording medium comprising a disk-shape substrate made of transparent resin with a circular hold provided at the center of the substrate, with a resin film constituted of a ridge formed around the hole (page 1, lines 10-25) with Figure 9 showing the ridgy resin film raised above the surface of a resin layer. It would have been obvious to one of ordinary skill in the art to incorporate the ridgy resin film of Applicant's disclosed Figure 9 in the recording medium of Usami to increase the resiliency and integrity of the recordable information of the recording medium. Usami does not show that the recording medium has a height of the resin film or glass transition temperature as in instant claims 16 and 25. However, such height and glass transition temperature are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the height and glass transition temperature, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. height and glass transition temperature) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations

are optimizable as they directly affect the integrity of the recording medium. As such, they are optimizable. It would have been obvious to one of ordinary skill in the art to make the recording medium with the limitations of the height and glass transition temperature since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

4. Claims 15, 17-20 and 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

5. The previous restriction requirement of cancelled claims 1-11 has been withdrawn; however, the restriction requirement of amended claim 12 is maintained, rendering claim 12 to be a non-elected invention.

Applicant's arguments of rejection under 35 USC 103(a) as being unpatentable over WO 98/47140 in view of Takakuwa et al (U.S. 6,280,660) are moot based on grounds of new rejection.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

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The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

